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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,881	02/21/2002	Richard J. Nelson	A261-USA	9365

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EXAMINER

GETZOW, SCOTT M

ART UNIT PAPER NUMBER

3762

DATE MAILED: 02/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/080,881

Applicant(s)

NELSON ET AL

Examiner

Scott M. Getzow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 10, 12-32, 39, 40, 42-46, 49-51, 53 and 54 is/are rejected.
- 7) ☒ Claim(s) 3-8, 11, 33-38, 41, 47, 48 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,2,17-19,22-26,29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Mensink et al '031.

Mensink shows a sensor 40, and a controller 48 along with the support circuitry that feeds signals to the controller. Further, as stated explicitly in the abstract, Mensink provides a device that allows for programming parameters using an external magnetic field. Also, the dimensions of the housing set forth in the preamble of claim 1 is considered to not distinguish over the implantable device of Mensink since the device of Mensink would perform no differently if it had such dimensions. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984). Still further, the device of Mensink could be used with a conventional programming device, as taught in column 16, lines 20+.

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3. Claims 49-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson '947.

As set forth in column 8, lines 56+, the permanent magnet is enclosed in a programming head.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9,10,39,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mensink et al '031.

To use a magnetoresistive or saturated core sensor in place of the sensor shown in Mensink would have been obvious in that such sensors are well known in the art for their effective sensing of magnetic fields for use in implanted devices; see for example Vogel et al which shows the use of a magnetoresistive sensor in an implantable device.

6. Claims 12-16,20,21,27,28,42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mensink et al '031 in view of Thompson '947.

Mensink teaches all of the subject matter of the above claims except for measuring intensity and/or polarity of the applied external magnetic field.

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Thompson teaches such in use with an implantable device; see claims 15-18 of Thompson for example. To measure such characteristics of the external magnetic field allows for a more precise sensing of the magnetic field that will provide greater efficiencies in operation of the Mensink device.

7. Claims 53,54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson '947 in view of Prutchi et al '998.

Thompson teaches all of the subject matter of the above claims except where the magnetic field source is a coil. Prutchi teaches such a coil, in use with a programmer. It would have been obvious to use such with the invention of Thompson since a coil allows for different signals to be passed via the magnetic field due to modulation, thus increasing the usefulness of the magnetic field source; see figure 2 of Prutchi which shows modulator 136.

***Allowable Subject Matter***


8. Claims 3-8,11,33-38,41,47,48,52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Getzow whose telephone number is (703) 308-2997. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Scott M. Getzow  
Primary Examiner  
Art Unit 3762